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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,674	06/22/2000	Brian J. Brown	S63.2-9216	7508

490 7590 09/29/2004

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,674

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 24, 2004 has been entered.

Claim Rejections Base Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al (US 5,354,308) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simon et al (US 5,354,308) alone. Simon anticipates the claim language where

the first type of strut members as claimed are the zigzag ring of struts shown along the radius of where reference number 14 points in Simon, and the second type of struts as claimed are the ring of struts with fingers (16) at the ends of the stent of Simon; see Figures 4 and 5 as well as column 3, line 9 to column 4, line 27. In Figure 5, the struts are parallel to each other or can be because further compression is contemplated; see column 5, lines 12-27. The Examiner asserts that at the fully compressed state or minimum diameter, the struts are parallel to each other and equidistant from each other.

Alternatively, if one does not consider the claim language met by inherently meeting the parallel and equidistant struts limitation, the Examiner asserts that it would have been prima facie obvious to compress the stent to that point since the minimum diameter was contemplated by Simon (see column 4, lines 18-25). Such a compressed state would enable the stent to be inserted into the smallest catheter possible facilitating placement in the widest size range of blood vessels. In the compressed state, the struts would at least be substantially equidistant such that the claim language would be considered clearly obvious to an ordinary artisan.

With regard to claims 12 and 14, in the cooled soft state, the Nitinol material of Simon is ductile, and thus, balloon expandable to the extent required by the present claims.

With regard to claim 17, the middle section of Simon (see Figures 3 or 4) can be said to contain the connectors, and some of the struts of the middle section are oblique with respect to the longitudinal axis. For this reason, the claim language is fully met.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon et al (US 5,354,308) alone. Simon at least renders the claim language obvious as set forth above, but fails to disclose that the curved end segments are all of the same length. In Simon, all the end segments except those on the extreme left or right side are of the same length; see *supra*. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make all the curved end segment the same length because Applicants have not disclosed that doing so provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well because all but the curved segments on the fingertip ends are the same length. This difference would have a negligible effect on the overall structure. Therefore, it would have been an obvious matter of design choice to modify Simon to obtain the invention as specified in the claims.

Response to Arguments

Applicant's arguments filed June 25, 2004 have been fully considered but they are not fully persuasive.

The Section 112 rejection have been withdrawn due to the amendments made to the claims or due to the Applicants persuasive arguments.

In response to the argument that there would be no gaps between parallel struts in the unexpanded state, the examiner asserts that since the wire of the stent would not fit together filling all spaces therebetween, that there would inherently be gaps between

adjacent members. For example, if the wire was cylindrical, at best only a line of contact with an adjacent cylindrical wire could be possible. Furthermore, in the compressed state, there would be many adjacent members and gaps would inherently be present as they could not be fit together perfectly to eliminate all interstices.

In response to the traversal that adjacent members are not equidistant from each other, the Examiner assert that the struts of Simon, in the compressed state, would be at least substantially equidistant from each other. For this reason, the claim language is considered at least obvious over Simon alone.

In response to the traversal of Simon as it is applied against claims 18-20, the Examiner has altered the rejection such that the Applicants' comments are addressed. Applicants are referred to the new rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul B. Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
Art Unit 3738